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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,220	08/23/2000	Reinhard Schneider	195976US0	1106

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EXAMINER

KUMAR, PREETI

ART UNIT	PAPER NUMBER
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1751

24

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,220

Applicant(s)

SCHNEIDER ET AL.

Examiner

Preeti Kumar

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-11 are pending.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

3. Claim 1 is objected to because of the following informalities: The use of parenthesis within a claim is improper claim presentation and it is unclear whether the limitation within the parenthesis is part of the claimed invention. Appropriate correction is required.

4. Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 3, 5, 9, and 10 the use of "preferably" or "especially" render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 10 and 11 provide for the use of aminoalkanesulfinates, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-8 and 10-11 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beckmann et al. (WO 98/03725).

Beckmann et al. teach reductive post-cleaning of dyed or printed polyester textiles comprising treating the acid dye bath or washing bath with a mixture containing: (a) compound(s) of formula $Am[(CR_1R_2)mSO_2M]_{p,q}$ (I) mixed with enough acid-binding agent to increase the pH of the bath by 1-3 units; (b) optionally compound(s) of formula $A[(CR_1R_2)SO_3M]_{p,q}$ (II); and (c) optionally other

additives. See abstract.

Beckmann et al teach that if hydroxy-methanesulfinates, and hydroxy-methanesulfonates, are reacted with NH_3 there are obtained amines of the formulas $\text{HN}(\text{CR}_1\text{R}_2\text{SO}_2\text{M})_2$ or $\text{H}_2\text{NCR}_1\text{R}_2\text{SO}_2\text{M}$. See pg.9, ln.25-30.

Furthermore, Beckmann et al. teach that if hydroxy-alkanesulfinates, together with corresponding sulfonates, are reacted with primary or secondary amines then corresponding N-alkyl substituted aminoalkanesulfinates/-sulfonates are obtained, which possibly are mixed with non-reacted hydroxy-alkanesulfinates/-sulfonates. See page 10, lines 21-25 (translation).

Accordingly, the teachings of Beckmann et al. appear to anticipate the material limitations of the instant claims. However the English translation of the abstract has been relied upon for examination purposes. Alternatively, even if the broad teachings of Beckmann et al. are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the formula recited in the instant claims, and to use the amino alkane sulfinates in a process for controlled partial decolorization of textile material, since Beckmann et al. suggest a reductive post-cleaning of dyed or printed polyester textiles with an aminoalkanesulfinate of the formula I as recited by the instant claims.

13. Claims 1-8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fono (US 4,27,881) and further in view of Beckmann et al. (WO 98/03725).

Fono teaches an improved aqueous stripping liquid and process for stripping dyes from textile fabric which comprises treating fabric in a heated aqueous solution of sodium hydroxymethane sulfinat, ammonium cations and sulfite anions. See abstract.

Specifically, Fono teaches the critical combination of sodium hydroxymethane sulfinat, an ammonium salt and a sulfite salt in an aqueous stripping liquid having a pH of from about 5 to 9 a variety of fabric substantive dyes can be stripped from a variety of fabrics using a temperature of at least about 140° F. See col.2, ln.5-10. Fono teaches that the stripping liquid is prepared by dissolving sodium hydroxymethane sulfinat and ammonium and sulfite salts in heated water to form ammonium cations and sulfite anions. Preferably, the stripping liquid is prepared by adding sodium hydroxymethane sulfinat to a container in which ammonium and sulfite salts have been dissolved in heated water to provide ammonium cations and sulfite anions since the presence of ammonium cations and sulfite anions in the stripping liquid enhance the stripping ability of the sodium hydroxymethane sulfinat. The stripping liquid contains about 1% to 3.5% of each salt based on the weight of the fabric to be stripped and preferably about 1% to 2% of each salt. See col.2, ln.40-55.

Also, Fono teaches stripping of vat dyes even if a dye-complexing carrier such as polyvinyl pyrrolidone is used to keep the dye from recombining with the fabric fibers once it is stripped. The amount of sodium hydroxymethane sulfinat used in the stripping liquid of the present invention is about 1/3 to 1/2 of the amount of reducing agent. Fono teaches the importance of this balance ratio to the dye industry since a decrease in the amount of reducing agents in the effluent decreases the chemical

oxygen demand of the dye waste water which makes the waste water less harmful to the environment. See col.3, ln.55-70.

In example 17, Fono illustrates superior stripping results are obtained using a critical combination of sodium hydroxymethane sulfinate, ammonium sulfate and sodium sulfite to strip acrylic skeins. See col.8, ln.5-35.

However, Fono does not specifically teach an aminoalkanesulfinate of the formula I as recited by the instant claim 1.

Beckmann et al. are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made to develop a process for controlled partial decolorization of textile material which comprises treating the textile material to be lightened with an aminoalkanesulfinate of the formula I, with a reasonable expectation of success because the teachings of Fono in combination with Beckmann et al. suggest a process for controlled partial decolorization of textile material which comprises treating the textile material to be lightened with an aminoalkanesulfinate in general.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 703-305-0178. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9309.

PK
July 29, 2002

Preeti Kumar
Examiner
Art Unit 1751

GREGORY DELCOTTO
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "G. Delcotto", written over the printed name of the primary examiner.